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In re Application of
DUBOIS
Application No.: 09/202,217
PCT No.: PCT/FR97/01023
Int. Filing Date: 10 June 1997
Priority Date: 11 June 1996
Attorney's Docket No.: 146.1307
For: NEW DEVICES INTENDED FOR THE
TRANSDERMIC ADMINISTRATION OF
TRIMEGESTONE, THEIR PREPARATION
PROCESS AND THEIR USE AS MEDICAMENTS

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DECISION ON
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PETITION UNDER
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37 CFR 1.47(b)
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This decision is in response to the RENEWED PETITION UNDER 37 CFR 1.47(b) filed 06 April 2000.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01023, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 09 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee.

On 21 September 1999, applicants filed a PETITION UNDER RULE 42. The petition was accompanied by: the petition fee; a declaration of Jean-Claude Vieillefosse setting forth facts entitled DECLARATION UNDER RULE 47 (hereinafter "first declaration of facts"); a declaration of Mr. Vieillefosse on behalf of and as agent for the non-signing inventor; and

Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

However, Exhibits A and D-F were not in the application file. Additionally, the listing of "Enclosures" in the petition did not include the documents corresponding to Exhibits A and D-F.

On 27 October 1999, the USPTO mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 04 November 1999, applicant filed a RESPONSE to the NOTIFICATION OF MISSING REQUIREMENTS stating that a petition under Rule 42 was filed on 21 September 1999. The RESPONSE included a postcard receipt. Note that this postcard receipt did not list the items which comprised Exhibits A and D-F.

On 09 March 2000, the USPTO mailed a decision indicating that the petition under 37 CFR 1.42 was dismissed because an oath or declaration by the legal representative of the deceased inventor had not been presented. The decision also discussed the petition and supporting documentation as it related to 37 CFR 1.47(b) for petitioner's information only.

On 06 April 2000, applicants filed the present RENEWED PETITION UNDER 37 CFR 1.47(b). The renewed petition was accompanied by a second declaration of facts (hereinafter "second declaration of facts") by Jean-Claude Vieillefosse and purportedly Exhibits A and D-F, which were missing from the submission of 21 September 1999. The sheet marked Exhibit A, however, is not a declaration of designation of inventors signed by Mr. Dubois but is rather an attestation certifying that Mr. Dubois was an employee of Hoechst Marion Roussel from 02 September 1985 to 31 December 1997. (It is also noted that Exhibits D and E were mislabeled.) English translations of Exhibits D-F were also provided. The renewed petition was also accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be

reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. As indicated in the previous decision, applicants have satisfied items (1) and (6) above.

In regard to item (5) above, applicant attempts to demonstrate sufficient proprietary interest in the application by showing that the inventor, Mr. Dubois, has agreed in writing to assign the invention. The following proofs are provided in support:

- Employment contract of Mr. Dubois (Exhibit C) (with English translation);
- Attestation of Mr. Dubois employment (not a labeled Exhibit) (with English translation); and
- French Law No. 92-597, Section II, Right to Title (Exhibit B) (with English translation).

MPEP § 409.03(f) states in part:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

The second declaration of facts states that “it is clear from the present record that Mr. Dubois is the inventor as can be seen from Exhibit A which is a declaration of designation of inventor signed by him and the copy of the employment contract and French Law with English translation fled [sic] as Exhibits B to E.” As discussed in the decision mailed 09 March 2000, however, if the declaration for designation of inventors is relied upon, an English translation should be provided. No such translation has been provided. Moreover, it is noted that Exhibit A itself has still not been submitted. As noted above, the paper submitted 06 April 2000 marked Exhibit A is not a declaration of designation of inventors and Exhibit A does not appear to have been submitted with the petition filed 21 September 1999. It was also noted in the decision mailed 09 March 2000 that if the French Law Section is to be relied upon for showing proprietary interest rather than the employment contract, a legal memorandum as described in the last paragraph of MPEP 409.03(f) would be required. No such legal memorandum has been provided. Moreover, with respect to the employment contract, an affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant is required.

As to item (4), the declaration must be made by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor. The submission filed 06 April 2000 makes clear that

Jean-Claude Vieillefosse has authority to sign the declaration on behalf of Hoechst Marion Roussel. Consequently, item (4) has been met.

As to item (3), the renewed petition states that the address at 63 rue de Meauz, 75019 Paris, France, is the last known address of Mr. Dubois. Consequently, item (3) has been met.

As to item (2), petitioner contends that DUBOIS refuses to execute the application. MPEP § 409.03(d) states in part:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

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Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the decision mailed 09 March 2000, it was noted that the first declaration of facts by Mr. Vieillefosse was not signed by a person having firsthand knowledge of the facts recited therein. The second declaration of facts states that "as noted in the declaration of September 1, 1999, Mr. Dubois has orally refused in his telephone conversations with Mr. Vieillefosse to execute the present application." However, the earlier declaration merely states that "Mr. Dubois has indicated that he will not execute the documents." As noted above, when there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. No such details have been provided.

Also regarding item (2), Exhibits D-F were purported in the petition filed 21 September 1999 to be offered as proof of the refusal of Mr. Dubois and were discussed on page 2 of the first declaration of facts by Jean-Claude Vieillefosse. However, these Exhibits were not discussed in the decision mailed 09 March 2000 because they were not in the application file and did not appear to have been sent. Copies of these Exhibits (and English translations) have been provided with the submission of 06 April 2000 and thus are addressed now. Specifically, the Exhibits are as follows:

- letter from Manuela Louvet to Mr. Dubois dated 09 November 1998 requesting his address (Exhibit D);

- telefax from Jean-Claude Vieillefosse to Mr. Dubois dated 02 December 1998 requesting his address (Exhibit E);

- letter from Jean-Claude Vieillefosse to Mr. Dubois dated 30 December 1998 which included the application, declaration, and assignment for execution (Exhibit F).

Further, at least one "recent telephone conversation" between Jean-Claude Vieillefosse and Mr. Dubois is referenced on the first line of the 30 December 1998 letter, and "repeated telephone calls" by Jean-Claude Vieillefosse and Mr. Dubois are referenced on page 3 of the first declaration of facts. These correspondences and the reference to "repeated telephone calls", however, are not adequate factual proof that Mr. Dubois refuses to execute the application. The three correspondences merely demonstrate that two attempts were made to contact Mr. Dubois regarding his address, and that in the third correspondence he was provided with the application, declaration, and assignment for execution. Apparently, sometime between the second and third correspondences (02 December 1998 to 30 December 1998), at least one telephone conversation between Mr. Vieillefosse and Mr. Dubois occurred, as referenced on the first line of the 30 December 1998 correspondence. However, no details or documentation of such telephone conversation have been provided, including whether Mr. Dubois indicated that he would execute such documents.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)", whichever is appropriate. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the

Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the PCT Legal Office.




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